REMARKS

Applicants submit an Excess Claim Fee Payment Letter for five (5) excess total claims.

Claims 1 and 4-27 are all the claims presently pending in the application. Claims 1, 5-6, 11, 14, and 16 are amended to more clearly define the invention and claims 21-27 are added. Claims 1, 6, 11, 14, and 16-20 are independent.

These amendments are made only to more particularly point out the invention for the Examiner and not for narrowing the scope of the claims or for any reason related to a statutory requirement for patentability.

Applicants also note that, notwithstanding any claim amendments herein or later during prosecution, Applicants' intent is to encompass equivalents of all claim elements.

Applicants gratefully acknowledge that claims 11-19 are allowed. However, Applicants respectfully submit that all of the claims are allowable.

Claims 1, and 4-5 stand rejected under 35 U.S.C. § 112, first and second paragraphs and claims 1, 4-10, and 20 stand rejected as being anticipated by the Schleif reference.

These rejections are respectfully traversed in the following discussion

I. THE CLAIMED INVENTION

A first exemplary embodiment as defined, for example, by independent claim 1, the claimed invention is directed to a composite holding device that includes a casing for accommodating a plurality of holders for holding media to serve either different or similar purposes, supporting sections, each of which supports the corresponding holder and movable in an axial direction in the casing together with the holder, a feed mechanism, provided in the

casing, for selectively advancing one of the supporting sections, and a manipulating mechanism for operating the feed mechanism, being adapted to project a tip of one of the plurality of holders out of a fore end opening at a tip of the casing and make usable a tip of one of the plurality of holders. Each supporting section is adapted to support a section of each holder such that the supported section is adapted to be rotatably supported in relation to the supporting section. A spherical bearing is formed between the supporting section and the supported section provided on each of the holders. The spherical bearing includes a spherical part formed on either one of the supporting section and the supported section provided on a holder and a concave part formed on the other one of the supporting section and supported section provided on the holder to receive the spherical part.

In a second exemplary embodiment as defined by, for example, independent claim 6, the claimed invention is directed to a composite holding device that includes a holder body for holding a first medium to serve a prescribed purpose, an external sleeve having a fore end receiving a portion of the holder body and a cap received by a rear end of the external sleeve. The cap includes a casing for accommodating a plurality of holders, a supporting section for supporting the holders to be movable in an axial direction in the casing, a feed mechanism, provided in the casing, for selectively advancing one of the plurality of holders, and a manipulating mechanism for operating the feed mechanism, being adapted to project a tip of one of the plurality of holders out of a fore end opening at a tip of the casing and make usable the tip of one of the plurality of holders. Each holder is for holding a second medium to serve a purpose either different from or similar to that of the first medium.

In a third exemplary embodiment as defined by, for example, independent claim 20, the claimed invention is directed to a holding device that includes a casing for

accommodating a plurality of holders for holding media, a supporting section for supporting the holders to be movable, means for selectively advancing one of the plurality of holders, and means for operating the advancing means, being adapted to project a tip of one of the plurality of holders out of a fore end opening at a tip of the casing and make usable the tip of one of the plurality of holders. The supporting section is adapted to support a section of each holder such that the supported section is adapted to be rotatably supported in relation to the supporting section.

Conventional devices (such as shown by the Schleif reference) require that the holder forcibly deviate toward the opening in the sleeve case as a result of contact with the inner surface of the sleeve case. Therefore, the holders may become caught by the inner face of the sleeve case and may, thereby, be prevented from projecting out of the opening in the end of the sleeve case.

Additionally, this requirement that the holder be flexible limits the freedom in the choice of material and the dimensions of the holder.

Further, these conventional devices only permit the selective use of one of two holders which limits the range of applicability of different types of media.

In stark contrast, the present invention provides, in independent claim 1, a spherical bearing formed between the supporting section and the supported section provided on each of the holders. The spherical bearing includes a spherical part formed on either one of the supporting section and the supported section provided on a holder and a concave part formed on the other one of the supporting section and supported section provided on the holder to receive the spherical part.

In this manner, the holders are allowed to rotate freely within the spherical bearing.

Thus, the holders do not have to be flexible in order to bend along an inner surface of the sleeve case and the choice of materials may be significantly increased.

Further, the dimensions of the holder may also be reduced since the holder does not have to bend or be flexible.

Additionally, the present invention provides, in independent claim 6, a cap that has a casing, a supporting section, a feed mechanism, and a manipulating mechanism. In this manner, the present invention not only may provide, for example, a holder at the conventional end of a writing instrument (rear side), but the present invention provides a cap (at a fore side) which incorporates features which enable the cap to provide additional holders. In this manner, the present invention increases the number of holders which are provided within a single device and, thereby, increases the availability of different types of media.

II. THE 35 U.S.C. § 112 REJECTIONS

The Office Action rejects claims 1 and 4-5 as failing to comply with the written description requirement and for being indefinite. While Applicants submit that such would be clear to one of ordinary skill in the art taking the present Application as a whole, to speed prosecution claims 1 and 4-5 have been amended in accordance with Examiner Prunner's very helpful suggestions.

In view of the foregoing, the Examiner is respectfully requested to withdraw these rejections.

III. THE PRIOR ART REJECTION

The Examiner alleges that the Schleif reference teaches the claimed invention. Applicants submit, however, that there are elements of the claimed invention which are neither taught nor suggested by the Schleif reference.

Independent claim 1 recites that a spherical bearing is formed between the supporting section and the supported section provided on each of the holders and the spherical bearing includes a spherical part formed on either end of the supporting part and the supported section provided on a holder and a concave part formed on the other one of the supporting section and the supported section provided on the holder to receive the spherical part.

Similarly, independent claim 20 recites a supporting section that is adapted to support a section of each holder such that the supported section is adapted to be rotatably supported in relation to the supporting section.

As explained above, these features are important for allowing the holders to rotate freely within the spherical bearing. Thus, the holders do not have to be flexible in order to bend along an inner surface of the sleeve case and the choice of materials may be significantly increased.

Further, the dimensions of the holder may also be reduced since the holder does not have to bend or be flexible.

The Examiner states that the Schleif reference discloses "a casing (constituted by bottom part 1 and top part 2) accommodating a plurality of holders or holder bodies (constituted by writing cartridges 22 and 23) holding media (ball point pens), supporting parts (constituted by tubes 17) . . . . wherein each supporting part 17 is adapted to support a section of each holder 22, 23 such that the supported section is adapted to be rotatably supported in

relation to the supporting part 17 (note lines 52-56 in col. 1)."

In other words, the Examiner alleges that the tube 17 corresponds to the supporting section, that the supported section corresponds to the writing cartridges 22 and 23, and that spherical bearing corresponds to the spherical top of slider 13 and the concave part of the casing 20.

If the above comparison was correct, a spherical bearing (i.e. 13 and 20) could not be formed between the supporting part (17) and the supported part (22 and/or 23). The spherical bearing includes a "spherical" portion, and it is not clear which portion the Examiner thinks is spherical in the Schleif reference.

Contrary to the Examiner's allegation the tube 17 does not rotatably support the writing cartridges 22 and 23. Indeed, in stark contrast to the present invention the Schleif reference explains that the "small tube [is] for receiving and holding the upper end of the writing cartridge" (emphasis added, col. 2, lines 14-17) and that the "small tubes with the writing cartridges inserted and held therein" (emphasis added, col. 1, lines 53-54).

Applicants note that the Examiner has cited col. 1, lines 52-56 in an attempt to support the allegation that the Schleif reference discloses that the small tubes rotatably support the writing cartridges. However, the only reference to anything which is rotatably supported is the casing 20 relative to the guide tube 8 and not the tubes 17 rotatably supporting the writing cartridges 22, 23. "By rotating the casing, the one or the other slide, and thus the small tubes with the writing cartridges inserted and held therein, are alternately pushed toward the bottom of the writing instrument and into the writing position" (col. 1, lines 52-56).

Indeed, the Schleif reference clearly further explains that "in order to exchange the

writing cartridges 22, 23, it is necessary only to rotate casing 20 with respect to guide tube 8. This may be accomplished, for example, by rotating the barrel part 1 relative to the barrel part 2 and fixing one or the other of casing 20 or guide tube 8 to these barrel parts." (Col. 3, lines 56-61).

Therefore, the Examiner's citation of col. 1, lines 52 - 56 in an attempt to provide support for the Examiner's allegation that the tubes rotatably support the writing medium merely illustrates that the Examiner is confused and has, as a result, misunderstood, misrepresented and mischaracterized the disclosure provided by the Schleif reference.

The Examiner next alleges that "a spherical bearing (constituted by spherical top of slides 13 (note Fig. 8) and the concave part of the casing 20 (note Fig. 1)) is formed between the supporting part and the supported section provided on each of the holders 22, 23 (note Fig. 1)."

First, contrary to the Examiner's allegation, the slides 13 do not include a spherical top, a spherical bearing and/or a spherical part.

Rather, the outer contours of the slides 13 are cylindrical, not spherical.

The Examiner alleges that "the spherical bearing includes a spherical part (constituted by the spherical top of slides 13 (note Fig. 8)."

In view of this continued allegation, the Applicant can only assume that the Examiner does not understand the meaning of the term "spherical" and the differences between a "spherical" part and a part which is "cylindrical."

Therefore, Applicant encloses for the Examiner's convenience, excerpts from two separate dictionaries which include definitions of the terms: "cylinder," "cylindrical," "cylindrical surface," "sphere," and "spherical." Indeed, the definitions for "cylinder" and

"sphere" include illustrations to assist the Examiner.

A cylinder is defined as: 1) "a surface or solid bounded by two parallel planes and generated by a straight line moving parallel to the given planes and tracing a curve bounded by the planes and lying in a plane perpendicular or oblique to the given planes." (Webster's Encyclopedic Unabridged Dictionary of the English Language, 1989, page 360); or 2) "a solid bounded by a cylindrical surface and two parallel planes, or the surface of such a solid." (McGraw-Hill Dictionary of Scientific and Technical Terms, Fourth Edition, 1989, page 478).

A cylindrical surface is defined as "[a] surface consisting of each of the straight lines which are parallel to a given straight line and pass through a given curve." (Id.).

Figures 8 and 9 of the Schleif reference clearly illustrate that the outer contour of the slide 13 is a cylindrical surface. Figure 8 is a top view of the slide and Figure 9 is a side view of the slide (col. 2, lines 55-56). Figure 8 illustrates the "given curve" through which the straight lines pass (into and out of the paper) to establish the cylindrical surface on the slider 13. Figure 9 looks directly down onto the cylindrical surface of the slider 13 and the straight lines of the cylinder are parallel to the paper while the "given curve" extends into and out of the paper in Figure 9.

In the "Response to Arguments" section of the May 17, 2004 Office Action, the Examiner alleges that "each side (as shown in Fig. 8 of the reference) clearly has a spherical portion constituted by the arched portions or segments." However, these "arched portions" that is illustrated by Figure 8 represent the "given curve" of the cylindrical surface in accordance with the definition provided above.

In contrast to the cylindrical surface on the slider 13, a sphere is defined as: 1) "[t]he

set of all points in a euclidean space which are a fixed common distance from some given point; in euclidean three-dimensional space the Riemann sphere consists of all points (x,y,z) which satisy the equation $x^2 + y^2 + z^2 = 1$." (Id at page 1789); and 2) a solid geometric figure generated by the revolution of a semicircle about its diameter; a round body whose surface is at all points equidistant from the center. Equation: $x^2 + y^2 + z^2 = 1$." (Webster's Encyclopedic Unabridged Dictionary of the English Language, 1989, page 1369).

Clearly, none of the surfaces of the slider 13 of the Schleif reference comprise a spherical surface.

Indeed, none of the surfaces on any part of the writing device that is disclosed by the Schlief reference are spherical.

Second, the Examiner alleges that the "supporting parts [are] (constituted by tubes 17)" and that the tubes 17 "supports a corresponding holder" which are "(constituted by writing cartridges 22 and 23)." The Examiner is alleging that the spherical bearing is formed between the slider and the casing. Therefore, by the Examiner's own description the Examiner's "spherical bearing" is not formed between the supporting section (tube 17) and the supported section (writing cartridges 22, 23) as recited by the independent claim 1.

This misunderstanding of the Schleif reference is continued in the "Response to Arguments" section of the May 17, 2004 Office Action where the Examiner alleges that "each holder in the Schleif reference has a spherical bearing constituted by that portion or half of the slider in which each is disposed (note Figs. 4 and 8 of the reference)."

As explained above, the claims recite a spherical bearing between the supporting section (which the Examiner contends reads on the tube 17) and the supported section (which the Examiner alleges reads on the writing cartridges 22 and 23). However, in the "Response

to Arguments" the Examiner cites the outer cylindrical surface which forms a linear bearing between the slider 13 and the inside of the guide tube 8 (col. 4, lines 7-8).

In other words, the Examiner refers to the linear slide bearing between the slide 13 and the guide tube 8 when attempting to allege that this linear slide bearing corresponds to the connection between the slide 13 which has a small tube 13 which holds the upper end of the writing cartridge (col. 2, lines 13 - 17).

Clearly, contrary to the Examiner's allegation, the linear bearing between the slide 13 and the guide tube 8 does not correspond to the connection between the slide 13 and the writing cartridge 22, 23.

Moreover, the ball point pen disclosed by the Schleif reference suffers from the problems which are solved by the present invention. As shown by Fig. 9, the small tube 17 (holder), which is connected to one of the front cartridges 22 or 23, is firmly affixed to the cylindrical attachment 16 of the slide 13. Therefore, the small tube 17 cannot rotate relative to the slider 13 and, as a result, the front cartridge, which is axially aligned between the cylindrical attachment 16 and the circular bore 12, is forced to contact the inner surface of the bottom part 1 before the front cartridge can exit from the opening in the bottom part 1.

In other words, the small tube 17 and the front cartridge 22 or 23 is aligned with the cylindrical attachment 16 and the circular bore 12 which is radially offset from the opening in the bottom part 1. Thus, in order for the front cartridge 22 or 23 to exit the opening in the bottom part 1, the front cartridge 22 or 23 must contact the inner surface of the bottom part 1 and be forcibly bent in order to exit the opening.

In stark contrast, the present invention provides a spherical bearing which enables the holder to freely rotate. Therefore, the holders of the present invention are not required to

flexibly bend and do not have to contact the inner surface of the sleeve.

Lastly, independent claim 6 recites a composite holding device that includes a holder body for holding a first medium to serve a prescribed purpose, an external sleeve having a fore end receiving a portion of the holder body and a cap received by a rear end of the external sleeve. The cap includes a casing for accommodating a plurality of holders, a supporting section for supporting the holders to be movable in an axial direction in the casing, a feed mechanism. Each holder is for holding a second medium to serve a purpose either different from or similar to that of the first medium. As explained above, these features are important for increasing the number of holders which are provided within a single device and, thereby, increases the availability of different types of media.

The Examiner alleges that the Schleif reference discloses a "cap (constituted by the bottom part 1 of the barrel)."

However, while the Schleif reference may discloses a cap supporting a holders holding a second medium , the Schleif reference does not teach or suggest a holder body holding a first medium where the holder body is received by a fore end of an external sleeve and which also receives the cap at a rear end.

Lastly, regarding the means plus function recitations of independent claim 20, the Examiner has failed to interpret the claims to read only on the structures or materials disclosed in the specification and "equivalents thereof." The Federal Circuit has made it clear that the Office is required to interpret means plus function language in accordance with 35 U.S.C. § 112, sixth paragraph (see M.P.E.P. §2106; *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) and *In re Alappat,* 33 F.3d 1526, 1540 (Fed. Cir. 1994)). Clearly, the Examiner has failed to interpret the claims to read only on the structures or materials

disclosed by the present specification and "equivalents thereof."

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 1, 4-10, and 20.

IV. FORMAL MATTERS AND CONCLUSION

The Office Action notes informalities in claims 1, 11, 14, and 16. This Amendment amends claims 1, 11, 14, and 16 in accordance with Examiner Prunner's very helpful suggestions.

In view of the foregoing amendments and remarks, Applicants respectfully submit that claims 1 and 4-27, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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James E. Howard
Registration No. 39,715

McGinn & Gibb, PLLC
8321 Old Courthouse Rd., Suite 200
Vienna, Virginia 22182
(703) 761-4100
Customer No. 21254